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In re Application of	:
SCHMID, Karl Heinz et al.	: DECISION ON
PCT Application No.: PCT/EP00/08960	:
Int. Filing Date: 14 September 2000	: REQUEST UNDER
Priority Date: 23 September 1999	:
Attorney's File Reference: C 2079 PCT/US	: 37 CFR 1.497(d)
For: COSMETIC AND/OR	:
PHARMACEUTICAL PREPARATIONS	:
CONTAINING DICARBOXYLIC ACID	:
MONOESTERS	:

This is a response to applicant's "REQUEST FOR CORRECTION OF INVENTORSHIP" filed 22 August 2002 which is being treated as a request under 37 CFR 1.497(d) to add Josef Koester (Koester) as an inventor. The \$130 fee under 37 CFR 1.497(d)(2) and 1.17(i) has been charged to applicant's deposit account.

BACKGROUND

On 14 September 2000, applicants filed international application number PCT/EP00/08960 claiming a priority date of 23 September 1999. The application named Karl Heinz Schmid (Schmid), Bernd Fabry (Fabry), and Alfred Westfechtel (Westfechtel) as inventors.

On 02 March 2001, applicants filed a Demand for international preliminary examination. Accordingly, the 30-month deadline for entry into the US national stage expired at midnight on 25 March 2002 since 23 March 2002 was a Saturday.

On 07 June 2001, the International Bureau mailed a Notification of the Recording of a Change (Form PCT/IB/306) indicating that Ansgar Behler (Behler) had been added as an inventor.

On 22 March 2002, the applicants filed a transmittal letter for entry into the US national stage under 35 USC 371 which was accompanied by, inter alia, a declaration including the names and signatures of co-inventors Schmid, Fabry, and Westfechtel. The declaration did not list Behler as a co-inventor.

On 22 May 2002, the US designated/elected Office (DO/EO/US) mailed a Notification of Missing Requirements (Form PCT/DO/EO/905) indicating, inter alia, that the declaration filed 22 March 2002 did not comply with 37 CFR 1.497 since co-inventor Behler was not included thereon and that a compliant declaration as well as a \$130 late fee for filing the oath/declaration later than thirty months from the priority date were required. The notification set a two month time period for response but indicated that extensions of time were available under 37 CFR 1.136(a).

On 22 August 2002, applicants filed the present "REQUEST FOR CORRECTION OF INVENTORSHIP" which is accompanied by, inter alia, a declaration, the \$130 fee for filing a declaration later than 30 months from the priority date, and a request and payment for a one-month extension of time. The request, signed by agent Steven J. Trzaska (Trzaska), asks for the addition of Koester as a co-inventor. The declaration includes the names and signatures of Schmid, Fabry, Westfechtel, Koester, and Behler.

DISCUSSION

37 CFR 1.497(d) states in part:

If the oath or declaration filed pursuant to 35 U.S.C. 371(c)(4) and this section names an inventive entity different from the inventive entity set forth in the international application, applicant must submit:

- (1) A statement from each person being added as an inventor and from each person being deleted as an inventor that any error in inventorship in the international application occurred without deceptive intention on his or her part;
- (2) The processing fee set forth in § 1.17(i); and
- (3) If an assignment has been executed by any of the original named inventors, the written consent of the assignee (see § 3.73(b) of this chapter)

* * * * *

The originally named inventors have assigned the above-identified US national stage application to assignee Cognis Deutschland GMBH & Co. KG (Cognis). Accordingly, the applicants must submit the requisite written consent of assignee Cognis in accordance with 37 CFR 1.497(d)(3).

CONCLUSION

For the above reasons, applicants request for the addition of Koester as a co-inventor is DISMISSED.

Applicant is advised that, as of May 1, 2003, the Office changed its correspondence address. Any further correspondence with respect to this matter deposited with the United States Postal Service on or after May 1, 2003 should be addressed to the Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



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